

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 07/402,450 Confirmation No.: 8131
Applicant : George J. MURAKAWA et al.
Filed : 1 September 1989
TC/A.U. : 1637
Examiner : Suryaprabha Chunduru

Attorney Docket No. : 2124-154
Customer No. : 6449

Mail Stop Appeal Brief - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REQUEST TO REOPEN PROSECUTION

Dear Sir:

In response to the Decision on Request for Rehearing dated 26 October 2011, Appellants hereby request that prosecution be reopened under 37 § 41.50.

I. STATUS OF APPEAL

In the Decision on Appeal, the Board reversed (i) the Examiner's rejection of claims 190-192, 194, 195, 197, 199-201, 203, 204, 206, 208-210, 212, 213, 215, 217-219, 221, 222, 224, 242-245 and 249-255 under 35 U.S.C. §135(b)(1) based on Wang (Wang et al.; US 5,219,727) and (ii) the Examiner's rejection of claims 193, 196, 198, 202, 205, 207, 211, 214, 216, 220, 223 and 225 under 35 U.S.C. §135(b)(1) based on Wang and Mullis (Mullis et al.; US 4,683,195). Although the Board reversed both of the Examiner's rejections, the Board entered two new grounds of rejection under the provisions of 37 C.F.R. § 41.40(b).

First, the Board rejected claims 190, 199, 208, 217 and 249-255 on grounds that Appellants are estopped from claiming subject matter that is not patentably distinct from the count in Interference 105,555 citing *In re Deckler*, 977 F.2d 1449 (Fed. Cir. 1992) and *In re Kroekel*, 803 F.2d 705 (Fed. Cir. 1986). Second, the Board rejected claims 190, 199, 208, 217 and 249-255 on grounds of estoppel under 37 C.F.R. §1.658(c). The Board only applied these

rejections to the independent claims and suggested that, if prosecution is continued, the Examiner should consider (i) whether the dependent claims are patentably indistinct from the count in Interference 105,055 or (ii) whether Appellants also could have moved to add the dependent claims during the interference.

In response to the Decision on Appeal, Appellants timely filed a Request for Rehearing to argue against the new grounds of rejection raised in the Decision on Appeal.

In the Decision on Request for Rehearing the Board held, with respect to the first new grounds of rejection, that the holding in the interference did not preclude the new rejection of the claims on appeal for interference estoppel based on *In re Deckler* and *In re Kroekel*. This holding by the Board, in essence, is an affirmation of the new rejection entered in the Decision on Appeal. With respect to the second new grounds of rejection, the Board noted that Appellants' arguments concerning estoppel under 37 C.F.R. § 1.658(c) were responsive to the reasoning set out in the Decision on Appeal, but concluded that they were not persuasive that estoppel under 37 C.F.R. § 1.658(c) should not apply. Since the Board's reasoning for this new grounds of rejection differed from the reasoning in the Decision on Appeal, the Board designated the new reasons for estoppel under 37 C.F.R. § 1.658(c) as a new grounds of rejection and also then designated the denial of rehearing as a new grounds of rejection to provide Appellants a fair opportunity to respond to both new grounds of rejection raised in the Decision on Appeal.

II. REQUEST TO REOPEN PROSECUTION

In response to the Decision on Request for Rehearing Appellants hereby request that prosecution be reopened for the instant application. Accompanying this Request is an Amendment in which the claims have been amended to delete the subject matter that the Board held to be barred by interference estoppel based on *In re Deckler* and *In re Kroekel* and by estoppel under 37 C.F.R. § 1.658(c). The claims have been amended such that they are limited to a reference RNA sequence and a target viral RNA sequence that can be amplified by different oligonucleotides which Appellants believe is not barred by either interference estoppel based on *In re Deckler* and *In re Kroekel* or estoppel under 37 C.F.R. § 1.658(c). Reconsideration of the instant application by the Examiner is requested in view of the amendment of the claimed subject

matter in accordance with the accompanying Amendment. Appellants request that the instant application be remanded to the Examiner for reconsideration.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

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